

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

By the foregoing amendment, claims 1 and 13 have been amended. Thus, claims 1-13 and 15-25 are currently pending in the application and subject to examination.

I. 35 U.S.C. § 112

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph as being indefinite because of the term "without user input." Claim 1 has been amended responsive to this rejection to recite "without user input of an identifier of the user." The Applicant submits that this claim is definite, because, although a user may have previously ordered the book, the Applicant submits that the comparing occurs in the library upon every receipt of a document in the library, and is not dependent upon any input of a user.

II. Art Based Rejections

In the Office Action mailed November 20, 2006, the Examiner rejected claims 1 and 11 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,428,529 to Hartrick et al. ("Hartrick"). Under 35 U.S.C. § 103(a), claims 2-10 are rejected as being unpatentable over Hartrick in view of U.S. Patent No. 5,509,074 to Choudhury ("Choudhury"); claim 12 as being unpatentable over Hartrick in view of U.S. Patent No. 4,985,697 to Boulton ("Boulton"); claims 13 and 17-19 as being unpatentable over U.S. Patent No. 6,243,071 to Shwartz et al. ("Shwartz") in view of U.S. Patent No. 5,089,956 to MacPhail ("MacPhail"); claim 15 as being unpatentable over Shwartz in view of MacPhail in further view of Boulton; claim 16 as being unpatentable over Shwartz in

view of MacPhail and further in view of U.S. Patent No. 4,644,470 to Feigenbaum ("Feigenbaum"); claim 20 as being unpatentable over Shwarts in view of MacPhail and further in view of Choudhury; and claims 21-25 as being unpatentable over U.S. Patent No. 5,739,814 to Ohara et al. ("Ohara") in view of Choudhury. It is noted that claims 1 and 13 have been amended. To the extent that the rejections remain applicable to the claims currently pending, the Applicant hereby traverses the rejections as follows.

A. Claims 1-11

The Applicant submits that Hartrick does not disclose or suggest a method of communicating between components of a home subsystem including at least the combination of portable, electronic viewer having a unique key associated therewith the method comprising in the library, **without user input of an identifier of the user**, comparing a unique key associated with data text of the electronic book to the unique key identifying the portable, electronic viewer, and storage of the text data in a viewer after comparing the unique key associated with data text of an electronic book to the unique key identifying the electronic viewer produces a match, as recited in amended claim 1.

The cited sections of Hartrick teach electronic documents including a password and before "any further display or printing", requiring the user to enter a password. (See column 4, lines 36-39). Hartrick specifically requires the entry of a password from a user before comparing the key of the text to the entered password.

The Applicant respectfully traverses the Office Action's characterization of an electronic viewer being a "collective entity of a human user and the computer as a whole." Electronic viewer, as used throughout this application is a physical component

completely separate from the user. (See, e.g. Figure 5 and page 6, lines 19-26, which depict a user as separate from a viewer, and Figure 11, page 17, lines 15-21).

Choudhury and Boulton fail to cure the deficiency in Hartrick.

For at least this combination of reasons, the Applicant submits that claim 1, as amended, is allowable over the cited art. As claim 1 is allowable, the Applicant submits that claims 2-12, which depend from allowable claim 1, as also allowable for at least the above described reasons and for the additional subject matter recited therein.

B. Claims 13, 15-20

The Applicant submits that Shwartz and MacPhail, taken alone or in combination (not admitted), do not disclose or suggest a method for processing text data for an electronic book in an electronic book home system comprising a library and viewer, the method including at least the combination of transmitting the purchase order of an electronic book from the electronic library to a remote operations center; attaching a unique packet identifier that matches an electronic library identifier associated with the purchaser's electronic library to a packet of text data at a remote operations center; after the unique packet identifier is attached, receiving the packet of text at the electronic library, if the packet has a unique identifier, determining whether the packet identifier matches the electronic library identifier of the electronic library; and if the packet identifier matches the electronic library identifier, storing the packet to a data file in an electronic library storage, as recited in amended claim 13.

The Office Action asserts that the installation of an electronic encyclopedia in Shwartz can be considered to be a result of purchasing the encyclopedia. The Applicant respectfully traverses and submits that, for example, although a user may

purchase the electronic encyclopedia before installing it, Shwarts does not disclose or suggest a method including at least the feature of transmitting a purchase order of an electronic book from the electronic library to a remote operations center.

The Office Action indicates that the library ID is equivalent to the librarian ID. However, the Applicant submits that Shwarts does not, for example, disclose or suggest either the library or the librarian having an ID or a library identifier.

The Office Action asserts that MacPhail teaches attaching a unique packet identifier that matches a library identifier associated with the purchaser's library to a packet of text data. However, the referenced section of MacPhail merely teaches a document management system that stores a set of descriptors associated with a document, when the document is filed in the server library. The Applicant respectfully submits that MacPhail does not, for example, disclose or suggest attaching a unique packet identifier that matches an electronic library identifier associated with the purchaser's electronic library to a packet of text data at the remote operations center. Instead, MacPhail, at the referenced citation, teaches attaching descriptors at the time that the electronic document is filed in the library.

Furthermore, the descriptors that MacPhail teaches, in the referenced section, correspond to the actual document itself, e.g. title, author, file, date filed, which allows documents in the system to be searched, and the system allows a security level to be associated with a document, allowing authorization of certain users. MacPhail does not therefore disclose or suggest, for example, attaching a unique packet identifier that **matches an electronic library identifier associated with the purchaser's electronic library to a packet of text data at the remote operations center.**

The cited section of MacPhail does teach a server library assigning each document a library-assigned document name (LADN). However, this name is assigned **after** the document is received at the library, for example, rather than **before** receiving a document at the library.

The Office Action indicates that each packet in MacPhail must have a unique identifier and that, because the server library performs services such as storing and retrieving documents electronically, the packet identifier must match the library identifier. However, in the referenced text of MacPhail, for example, a unique packet identifier is not attached to a packet of text data that matches a library identifier associated with a **purchaser's library before the packet is received at the library.**

The Office Action asserts that MacPhail teaches, after the unique packet identifier is attached, receiving a packet of text data, citing MacPhail's statement that a network is beneficial in electronic document processing. The Applicants respectfully submits that, although users may access the document in MacPhail after it has been stored at the library with an LADN, MacPhail does not disclose or suggest "after the unique packet identifier is attached, receiving the packet of text data **at the electronic library.**"

For at least this combination of reasons, the Applicant submits that claim 13, as amended is allowable over the cited art. As claim 13 is allowable, the Applicant submits that claims 15-20, which depend from allowable claim 13, are therefore also allowable for at least the above noted reasons and for the additional subject matter recited therein.

C. Claims 21-25

The Applicant submits that Ohara does not disclose or suggest a method for processing data text for electronic books in a home system comprising a library including at least sending a packet of data text, inserted in a video signal, from a remote operations center to the library, and decompressing and decrypting an electronic book page by page, just before a page is displayed on the screen of a viewer, as recited in claim 21.

The cited section of Ohara merely teaches that the electronic book includes “a control circuit, which outputs video and voice signals after processing signals from the input signal sensing circuit and signals from a ROM which stores the contents of the data of the aforementioned sheets.” Thus, Ohara, as cited, only stores data and includes a control circuit that outputs a video signal. However, Ohara does not teach a packet of data text inserted in the video signal, for example.

The Office Action admits that Ohara does not disclose or suggest sending a packet of data text, inserted in a video signal, from a remote operations center to a home subsystem library. The Office Action cites Choudhury as teaching at least this feature.

The Office Action asserts that the copyright server and document server in Figure 1 of Choudhury are qualified to serve as the remote operations center and the document library, respectively. The Applicant respectfully disagrees. The copyright server in Choudhury merely authenticates a request from a plurality of users and directs the document server to act upon a proper authentication of each request. The copyright

server does not send a packet of data text, inserted in a video signal, and the document server does not store said packet, as recited in claim 21.

The Office Action asserts that Choudhury must use a microprogram memory buffer to perform the functions of decrypting and displaying documents one page at a time. In contrast, the cited section of Choudhury merely describes a system that “decrypts and displays **the document.**” This section discloses or suggests nothing regarding page by page decompression and decryption, just before a page is displayed on the screen of a viewer, for example.

The Applicant again traverses the Office Action’s characterization that the “user is qualified as an electronic viewer.” Electronic viewer, as used throughout this application is a physical component completely separate from the user. (See, e.g. Figure 5 and page 6, lines 19-26, which depict a user as separate from a viewer, and Figure 11, page 17, lines 15-21).

For at least this combination of reasons, the Applicant submits that claim 21 is allowable over the cited art. As claim 21 is allowable, the Applicant submits that claims 22-25, which depend from allowable claim 21, are also allowable at least for the above noted reason and for the additional subject matter recited therein.

The Applicant submits that Boulton, and Feigenbaum fail to cure the deficiency in Choudhury, Hartrick, Shwarts, and Ohara.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law

of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at pages 6, 9, 11, 13, 14, and 16. This is an insufficient showing of motivation.

CONCLUSION

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicant hereby petitions for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300 with reference to Attorney Docket No. 026880-00017.

Respectfully submitted,

Arent Fox PLLC

A handwritten signature in black ink, appearing to read "Sheree Rowe", written in a cursive style.

Sheree T. Rowe
Attorney for Applicant
Registration No. 59,068

Customer No. 004372
1050 Connecticut Ave., N.W.
Suite 400
Washington, D.C. 20036-5339
Telephone No. (202) 715-8492
Facsimile No. (202) 638-4810